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No. 95-1369

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

RODIME PLC,
Petitioner,
v.
QUANTUM CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

JOHN F. LYNCH
Counsel of Record
RICHARD L. STANLEY
J. MIKE AMERSON
GARY J. FISCHMAN
ARNOLD, WHITE & DURKEE
750 Bering Drive
Suite 400
Houston, Texas 77057
(713) 787-1400
Counsel for Respondent Quantum Corporation

Of Counsel:
DAVID B. HARRISON
QUANTUM CORPORATION
500 McCarthy Boulevard
Milpitas, California 95035
(408) 894-6247

TERENCE M. FRUTH
DOUGLAS L. ELSASS
FRUTH & ANTHONY PA
3750 IDS Center
80 South Eighth Street
Minneapolis, Minnesota 55402
(612) 349-6969

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QUESTIONS PRESENTED

1) Did the Federal Circuit correctly determine that the '383 patent claims at issue were impermissibly broadened during reexamination proceedings in the Patent Office when the track density limitation was changed from "at least 600 concentric tracks per inch" to "at least approximately 600 concentric tracks per inch" so that the affected patent claims now covered certain disk drive devices with approximately *but less than* 600 tracks per inch that were not covered by the original claims?

2) Did the Federal Circuit correctly hold that Rodime's evidence as to how the phrase "600 tpi" is interpreted in disk drive product literature and in isolation from the rest of the disputed claim language was insufficient as a matter of law to demonstrate a genuine issue of material fact that could prevent summary judgment from being granted that the claims at issue had been broadened during reexamination by the addition of the term "approximately" to the limitation "at least 600 concentric tracks per inch"?

3) Upon concluding that the claims at issue had been broadened during reexamination proceedings in violation of the statutory prohibition in 35 U.S.C. § 305 that "[n]o proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding," did the Federal Circuit err in holding that any reexamined claims improperly broadened in violation of section 305 should be held invalid?

LIST OF PARTIES AND RULE 29.6 STATEMENT

The parties to the proceeding in the United States Court of Appeals for the Federal Circuit were petitioner Rodime PLC and respondent Quantum Corporation. For purposes of S. Ct. R. 29.6, Quantum Corporation states that it has no parent companies. Its only nonwholly owned subsidiary is Quantum Peripherals Colorado, Inc.

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BRIEF IN OPPOSITION

Respondent Quantum Corporation ("Quantum") respectfully requests that this Court deny the petition for a writ of certiorari seeking review of the Federal Circuit's decision in this case. The Federal Circuit's opinion is reported at *Quantum Corp. v. Rodime PLC*, 65 F.3d 1577 (Fed Cir. 1995), and is found at Petitioner's Appendix ("Pet. App.") 1a-18a. The district court's opinion granting summary judgment in favor of Quantum, which was affirmed by the Federal Circuit's opinion at issue, is reported at 851 F. Supp. 1382 (D. Minn. 1994), and is found at Pet. App. 19a-36a.

STATUTE INVOLVED

The pertinent statutory provision applicable to this case is 35 U.S.C. § 305, which governs "Conduct of Reexamination Proceedings" and provides:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. *No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter.* All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

(Emphasis added.) The text of this section is also found at Pet. App. 40a.

STATEMENT OF THE CASE

A. The Prosecution Of The '383 Patent

Rodime is the owner of U.S. Patent No. B1 4,638,383 ("the '383 patent"), drawn to "a computer disk drive system for operating a micro hard-disk" in which the micro hard-disk was capable of storing digital information at a specified track density measured in tracks per inch ("tpi"). Rodime's patent application which resulted in the '383 patent was filed on November 19, 1985.

As first submitted to the United States Patent and Trademark Office ("PTO"), Rodime's original application

specifically recited a claim to the narrow range of track densities signified by "approximately 600" tpi. After that claim was rejected during the original prosecution, Rodime canceled all pending claims and inserted seven new independent claims, including five claims referring to a specific track density of "at least 600" tpi. The word "approximately" had been eliminated in the track density limitation, replaced by "at least" in each new claim.

When substituting those claims, Rodime did not call the Examiner's attention to the fact that the track density limitation had been changed from "approximately 600" tpi to "at least 600" tpi nor did Rodime give any explanation for that change. Similarly, no attempt was made to amend the '383 patent specification, which speaks only of Rodime's disclosed invention having storage densities of "approximately 600" tpi—the language of the canceled claims. The '383 patent originally issued on January 20, 1987, with five claims specifying "at least 600 concentric tracks per inch." [1]

Shortly thereafter, Rodime quickly became a party to three infringement suits involving the '383 patent (none of which involved Quantum). In partial response to diverse invalidity defenses raised in those lawsuits, Rodime requested on September 28, 1987 that the PTO reexamine the original '383 patent. The PTO granted Rodime's reexamination request on November 11, 1987.

Early in the reexamination proceeding, Rodime submitted a sworn declaration of Dr. Norman White, Rodime's Technical Director, stating that a Rodime RO350 disk drive "brought to the United States prior to August 31, 1983 included all of the elements claimed in U.S. Patent 4,638,383." With respect to the originally issued '383 claims, however, Dr. White's sworn statement was erroneous. In 1983, Dr. Jack McGinley, a named inventor on the patent, had expressly calculated the greatest

[1] Those five claims include the only ones that have been asserted against Quantum in this litigation.

storage density of the Rodime disk drive referenced in Dr. White's declaration to be only 596 tracks per inch.

In conjunction with one of Rodime's post-issuance litigations, Dr. McGinley submitted a sworn statement (dated April 4, 1989) stating that "I believe that the '3½ drive' had an average track density of approximately 572 tpi and a maximum track density of less than 600 tpi." He further stated that "[t]o the best of my knowledge, all the RO 350 family disc drives, including those brought into the United States in 1983, had both an average and a maximum track density of less than 600 tpi." In that same lawsuit, Dr. White signed an affidavit on May 7, 1989 with respect to the same Rodime device, stating that "[a] more detailed calculation can be made, which yields a maximum track density of 597 tpi."

Because the relevant claims of the original '383 patent specified "at least 600" tpi at the time of Dr. White's erroneous PTO declaration, Rodime was seemingly on the horns of a dilemma. The original '383 claims specified a disk drive system having "at least 600" tracks per inch whereas Rodime's earliest alleged "date of invention" in this country consisted of a disk drive with a track density of *less than* 600 tracks per inch at every point on its surface. Without being able to establish that the Rodime disk drive allegedly brought to this country in April 1983 met every limitation of the '383 claims, Rodime would lose its best opportunity to predate important prior art with effective dates before the alleged effective filing date of the '383 patent.[2]

In April 1988, all but two claims of the original '383 patent were rejected during the reexamination in part based on prior art disclosing disk data storage densities of at least 600 tpi. On June 20, 1988, Rodime made multiple amendments including changing the claims con-

[2] In its request for reexamination, Rodime had acknowledged that proof of a "date of invention" earlier than its application filing date might be needed to predate another company's 3½-inch disk drive device.

taining the "at least 600" tpi limitation to recite "at least approximately 600" tpi and adding new claims incorporating the latter limitation. Once again, Rodime did not substantively discuss that amendment. Rodime also made no mention of Dr. White's declaration or of the potential impact its amendment had on preservation of Rodime's April 1983 "invention date."

Shortly thereafter, on September 19, 1988, a newly-assigned Examiner allowed the amended and new claims containing the "at least approximately 600" tpi limitation. No discussion of the addition of "approximately" was made in the reasons for allowance. The reexamination certificate issued on November 29, 1988.

B. The District Court Proceedings

On February 26, 1993, Quantum filed this declaratory judgment action in the United States District Court for the District of Minnesota, alleging that the '383 patent was invalid, unenforceable, and not infringed.[3] Rodime answered and filed a counterclaim for infringement. On April 11, 1994, Judge David S. Doty granted Quantum's motion for summary judgment of invalidity under 35 U.S.C. § 305, concluding that the '383 claims at issue between the parties were invalid for being impermissibly broadened during reexamination. Pet. App. 19a-36a.

While looking to discern the meaning of the phrase "at least 600 tpi" in the original claims at issue, Judge Doty properly construed the entire clause:

> The use of "at least" to modify "600 tpi" suggests that "600 tpi" is a minimum or a lowest value of the track density achieved in the invention. Rodime's use of "at least" in its claims would indicate that its

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[3] In November 1992, Rodime had sued another disk drive manufacturer for infringement of the '383 patent and for various counts of unfair competition. That case is entitled *Rodime PLC v. Seagate Technologies, Inc.*, Civil Action No. CV 92 6855 RG (JGx) (C.D. Cal.) ("the *Seagate* litigation").

> drives have densities starting at, but greater than, 600 tpi.

Pet. App. 25a-26a. Judge Doty properly relied on the ordinary meaning of "approximately" when read in the context of all of the words in the limitation at issue.

> The position of "approximately" in the phrase at issue requires that it be read to modify the value 600 and therefore, "600 tpi" is no longer an absolute value. The addition of the word "approximately," a word that is unquantifiable and indefinite, erodes the "not less than" meaning of "at least."

Pet. App. 26a. Judge Doty interpreted "600 tpi" as being an "absolute value" when interpreted in conjunction with the phrase "at least" in the original '383 claims. That absolute value is the minimum value of "600 tpi" which defines the bottom of an open-ended range.

In contrast to Rodime, Judge Doty properly looked at the effect on claim scope resulting from adding "approximately" to the entire phrase "at least 600 tpi." He acknowledged Rodime's assertion that "600 tpi" was a term of art in the disk drive art that was merely clarified when the term "approximately" was affixed as a modifier. Pet. App. 28a. However, he examined the '383 specification and determined that Rodime and the inventors had not disclosed a special meaning to "600 tpi" that differed from its ordinary meaning. Pet. App. 28a-30a. Thus, Judge Doty concluded that the addition of the term "approximately" as a modifier of "600 tpi" did not make the '383 claims more definite, but instead broadened their scope by incorporating an indefinite term. Pet. App. 30a.

Judge Doty also concluded that Rodime's expert declaration from Mr. Anthony LaPine was insufficient to show that a genuine issue of material fact existed because "his declaration merely states the general basis of understanding by those skilled in the art, that cited values for 'tracks per inch' are inherent approximations." Pet. App. 31a. Judge Doty noted that Mr. LaPine had not ad-

dressed the specific claim language at issue and held that "Rodime fail[ed] to establish that one of ordinary skill in the art would interpret the phrase in a manner inconsistent with its ordinary meaning." Pet. App. 32a. Thus, properly viewing the evidence in a light most favorable to Rodime, Judge Doty concluded "that a reasonable jury could not find the amended claims were not improperly broadened by the addition of the word 'approximately.' " Pet. App. 32a.

Finally, Judge Doty traced Rodime's amendment during the original prosecution from "approximately 600" tpi to "at least 600" tpi and Rodime's 1988 reexamination addition of "approximately" to the track density limitation. Pet. App. 33a-34a.

> In this case, the entire phrase "at least approximately 600 concentric tracks per inch" is never seen in the prosecution history prior to the reexamination amendment. Rodime cannot point to any preexisting uses of the entire phrase to demonstrate that the amendment merely clarified and did not broaden the claim. In fact, the opposite is shown.

Pet. App. 34a-35a. Based on that prosecution history, Judge Doty again concluded that Rodime's reexamination amendment was not simply clarifying what was already self-evident. *Id.* Judge Doty summarized his overall conclusion as follows:

> Based upon a review of the actual claim language, the specification in the patent, and the prosecution history of the patent: (1) the court finds that the addition of the word "approximately" during reexamination impermissibly broadened the scope of the claim; (2) no genuine issue of material fact exists that would allow a reasonable jury to conclude otherwise. Therefore, Quantum's motion should be granted.

Pet. App. 35a. Final judgment was entered on April 26, 1994. Pet. App. 37a.

C. The Federal Circuit's Affirmance

As stated by the Federal Circuit in rejecting Rodime's appeal, "[t]here are two issues in this case: first, whether Rodime broadened the scope of the claims at issue during reexamination in violation of 35 U.S.C. § 305 by changing the track density limitation from 'at least 600 tpi' to 'at least approximately 600 tpi,' and, second, assuming the claims were impermissibly broadened, the legal effect of violating section 305." Pet. App. 7a. As both the district court and the Federal Circuit correctly held as a matter of law, the first question can only be answered affirmatively. As to the latter, the Federal Circuit correctly concluded that broadening a claim during reexamination in violation of section 305 can only result in invalidity of the broadened claims. Pet. App. 13a-18a.

As to the first issue, the Federal Circuit recited the controlling legal premise that "[a]n amended or new claim has been enlarged if it includes within its scope any subject matter that would have not infringed the original patent." Pet. App. 7a (citing *In re Freeman*, 30 F.3d 1459, 1464 (Fed. Cir. 1994)). Just as in its current petition, Rodime's principal argument on appeal was that the addition of the word "approximately" to the track density limitation only made explicit what was already implicitly included in the claim, and thus did not expand the scope of the claims at issue. Pet. App. 8a. Specifically, Rodime asserted that to one of skill in the art, "600 tpi" means the same thing as "approximately 600 tpi." *Id.* Just like the district court, the Federal Circuit disagreed.

> The major flaw in Rodime's argument is that it focuses solely on the term "600 tpi" instead of the claim limitation as a whole, in context. Even if "600 tpi" means "approximately 600 tpi," as Rodime argues, it is unnecessary to read in an implicit range when interpreting "at least 600 tpi" because this limitation as a whole already expressly represents an open-ended range, i. e., 600 tpi and up. Therefore,

> that one skilled in the art understands "600 tpi" to connote a range is irrelevant because the limitation in dispute is "at least 600 tpi," and *Rodime has offered no evidence to show that one skilled in the art understood "at least 600 tpi" to be the same as "at least approximately 600 tpi" or that the patentee defined it as such in the patent or during prosecution.*

Pet. App. 9a (citations deleted) (emphasis added).

As to the phrase "at least 600 tpi," the Federal Circuit held that the term "at least" should be given its ordinary meaning of "as the minimum" which, when coupled with a specific number, sets forth an absolute lower limit of a range, i.e., 600 on up. Pet. App. 10a. The court then held that the addition of "approximately" eliminated the precise lower limit of that range, so that the term "at least approximately 600 tpi" in the '383 claims defined an open-ended range starting slightly below 600 tpi. *Id.* The Federal Circuit concluded "[s]ince the amended limitation includes subject matter not covered by the original claims, i.e., track densities below 600 tpi, we conclude that Rodime expanded the scope of their claims during reexamination in violation of 35 U.S.C. § 305." Pet. App. 11a. Finally, the Federal Circuit confirmed the accuracy of its conclusion by discussing the remarkable similarity between the relevant claim language and prosecution history of the present case to that in *Seattle Box Co. v. Industrial Coating & Packing Inc.*, 731 F.2d 818 (Fed. Cir. 1984). Pet. App. 11a-13a.

Turning to the second issue, the legal effect of violating section 305, the Federal Circuit held that "[d]espite the absence of specific statutory authority or precedent of this court in support of the district court's judgment that the claims at issue are invalid, we conclude that, as a matter of law, the district court arrived at the correct result." Pet. App. 16a ("As with violations of other statutes in the Patent Act, claims that do not comply with section 305 cannot stand."). The Court rejected Rodime's appeal

for the court to exercise its "inherent equitable powers" by restricting the scope of the claims to their original terms because (1) the courts are not to redraft claims under the guise of fairness or equity, and (2) the equities did not favor Rodime because they broadened their claims during reexamination despite the explicit prohibition against doing so in section 305. Pet. App. 17a (citations omitted).

The Federal Circuit also rejected Rodime's suggestion that the district court could remand the case to the PTO to have the broadening language deleted from the claims. Pet. App. 17a (citing *Green v. Rich Iron Co.*, 944 F.2d 852 (Fed. Cir. 1991)).

> To conclude otherwise would discourage instead of encourage compliance with section 305. If the only penalty for violating section 305 is a remand to the PTO to have the reexamined claims narrowed to be commensurate in scope with what the applicant was only entitled to in the first place, then applicants will have an incentive to attempt to broaden their claims during reexamination, and, if successful, be able to enforce these broadened claims against their competitors. This result essentially renders the prohibition [against broadening] in section 305 meaningless. The likelihood that improperly broadened claims will be held invalid will discourage applicants from attempting to broaden their claims during reexamination.

Pet. App. 17a-18a (citation omitted). Finally, the Federal Circuit held that the list of invalidity defenses in 35 U.S.C. § 282 was not exclusive, so that a violation of section 305 was properly determined to be an invalidity defense in a patent infringement action. Pet. App. 18a. As a result, the district court's judgment in favor of Quantum was affirmed.

REASONS FOR DENYING THE WRIT

I. THE FEDERAL CIRCUIT'S DECISION IS PLAINLY CORRECT

There is no reason for this Court to grant certiorari to review the propriety of the Federal Circuit's decision in this case, which only has ramifications for the validity of Rodime's '383 patent. On its face, Rodime's petition merely complains of a case-specific result reached by both the district court and the Federal Circuit, a result which was virtually compelled by the Federal Circuit's prior and indistinguishable decision in *Seattle Box Co. v. Industrial Coating & Packing Inc.*, 731 F.2d 818 (Fed. Cir. 1984). *See* Pet. App. 11a-13a.

As originally issued, the pertinent claims of the '383 patent were restricted to disk drive devices with a data storage density of "at least 600" tpi. During reexamination, Rodime inserted the term "approximately" so that those claims covered disk drive devices containing "at least approximately 600" tpi. The Federal Circuit correctly affirmed that the addition of "approximately" during reexamination clearly broadened the scope of the claims at issue with respect to the claimed track density. No other conclusion was even plausible.[4]

Rodime's petition asserts that the Federal Circuit never confronted that "600 tpi" is an inherent approximation which cannot provide a precise lower limit to the claimed track density range. Pet. 13. However, the Federal Circuit did not avoid or misapprehend anything:

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[4] *See, e.g., Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2 (Fed. Cir. 1987) ("A claim that is broader in any respect is considered to be broader than the original claims even though it may be narrower in other respects."); *Uniroyal, Inc. v. Rudkin Wiley Corp.*, 13 U.S.P.Q.2d 1192, 1195-96 (D. Conn. 1989) ("self-evident that the terms 'substantially' and 'approximately' broaden the scope of the claims"), *aff'd on other grounds*, 939 F.2d 1540 (Fed. Cir. 1991).

> The major flaw in Rodime's argument is that it focuses solely on the term "600 tpi" instead of the claim limitation as a whole, in context. Even if "600 tpi" means "approximately 600 tpi," as Rodime argues, it is unnecessary to read in an implicit range when interpreting "at least 600 tpi" because this limitation as a whole already expressly represents an open-ended range, i.e., 600 tpi and up. Therefore, that one skilled in the art understands "600 tpi" to connote a range is irrelevant because the limitation in dispute is "at least 600 tpi," and *Rodime has offered no evidence to show that one skilled in the art understood "at least 600 tpi" to be the same as "at least approximately 600 tpi" or that the patentee defined it as such in the patent or during prosecution.*

Pet. App. 9a (citations deleted) (emphasis added). Rodime's petition continues to insist upon a "piecemeal" interpretation that isolates the phrase "600 tpi" from the rest of the disputed claim language. Rodime's evidence was not ignored. As shown above, it was instead held inadequate to avoid summary judgment because it did not address the actual claim language at issue.

While testifying specifically about the language of the '383 claims at issue, even Dr. White, Rodime's former Technical Director, agreed that the phrase "at least 600 tracks per inch" specified a minimum value.

> Q: So doesn't at least 600 tracks per inch mean 600 tracks per inch, or 601, or more than that?
>
> A: I agree, it does.

Dr. McGinley, one of the named inventors of the '383 patent, also testified to the same effect while directly comparing the original and amended claim language:

> Q: Because the "at least 600 tracks per inch" did not admit of an amount lower than 600, correct?
>
> A: That is correct.

That testimony provided direct, uncontroverted evidence that persons of skill in the disk drive art interpret "at least 600 tracks per inch"—the exact phrase in question in the '383 claims at issue—in accordance with the ordinary English language meaning of that term, *i.e.*, as setting a minimum of not less than 600 tpi.[5]

By contrast, Rodime directed its expert opinion evidence to the meaning of the phrase "600 tpi" as used in disk drive product literature. *See* Pet. App. 44a (¶ 10). However, the single track density values in tables in product literature are not modified by "at least" or "at least approximately." For that reason, the usual interpretation of a single track density value listed by itself in product literature is simply irrelevant to how one skilled in the art would interpret the phrase "at least 600 tpi" as used by Rodime in the original '383 claims.

Mr. LaPine never addressed the effect of "at least" when coupled with a numerical value. Hence, Rodime's continued reliance on his declaration as support for interpreting the phrase "600 concentric tracks per inch" in isolation from the remainder of the language in the track density limitations at issue was properly rejected by the district court and by the Federal Circuit. *See* Pet. App. 9a; 31a-32a. More importantly, that declaration provides no basis for revisiting that issue for yet a third time by a writ of certiorari.

Rodime's argument that its belated addition of "approximately" did not change the scope of the claims because that was inherent in the phrase "600 tpi" is inconsistent with the prosecution history. As first filed, claim 1 was limited to "approximately 600" tpi (*i.e.*, a

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[5] Rodime's characterization of its change as a "clarification of the original language" (Pet. 6) is clearly an afterthought. *See Hormone Res. Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1564 (Fed. Cir. 1990) (patentee's arguments "are little more than a post-hoc attempt to redefine its claims during litigation").

narrow range on either side of the specific value of 600). Rodime then deleted "approximately" and substituted "at least" into the claims at issue during the original prosecution, so that those claims then unambiguously recited a minimum track density of 600 concentric tracks per inch. No other interpretation is possible. Both courts properly rejected Rodime's assertion that "approximately" was inherently present in the claims as issued in 1987 when that was the very word that was deleted by Rodime in 1986 when "at least" was substituted.

"Where an inventor chooses to be his own lexicographer, he must set out his uncommon definition in some manner within the patent disclosure." *See, e.g., Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992). Here, however, there is no contemporaneous indication in the '383 patent record of any basis on which to depart from the ordinary meaning of the claim language at issue. *See* Pet. App. 32a. The '383 specification does not even mention the phrase "at least 600" tpi or the broader phrase "at least approximately 600" tpi. Rodime departed from the specification entirely when the term "at least" was substituted for "approximately" before the original '383 claims issued. *See Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 871 F.2d 1054, 1071 (Fed. Cir. 1989) (construing claims to preserve validity does not justify reading a limitation into a claim that the patentee deleted during prosecution).

Nothing in the '383 specification alters the ordinary meaning of "at least" as setting a minimum. The Federal Circuit noted that Rodime offered no reason to depart from the plain meaning of the "at least" terminology in the original and reexamined '383 patent claims. Pet. App. 32a; *see also Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 546 (Fed. Cir. 1994) (holding "at least" [some number]" sets an absolute minimum in the absence of any contrary indication). Thus, when "at least" is coupled with a value such as "600 tpi," that number can only be

interpreted as a minimum that defines the lowest value in an open-ended range.[6]

The Federal Circuit correctly concluded that use of "about" or "approximately" in conjunction with the phrase "at least" allows the minimum value of the specified range to be expanded downward to cover additional values.[7] Pet. App. 10a. Rodime's addition of "approximately" to the claims of the '383 patent could only have been interpreted as having broadened the scope of the claims at issue now cover *at least one* conceivable disk tracks per inch. As a matter of law, the reexamined claims at issue now cover *at least one* conceivable disk drive device *with less than* 600 tpi that was not within the scope of the original claims. *See, e.g., In re Bennett*, 766 F.2d 524, 525-26 (Fed. Cir. 1985).

Because that is exactly what the Federal Circuit concluded, there is no arguable basis for granting Rodime's request for writ in this case. Rodime's evidence simply did not address the determinative claim interpretation issue, and Rodime has shown no acceptable reason why

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[6] *See also Kistler Instr. AG v. United States*, 628 F.2d 1303, 1318 (Ct. Cl. 1980) ("'at least one piezo-electric crystal . . . [means] one or more crystals"); *Allen-Bradley Co. v. Erie Resistor Corp.*, 104 F.2d 150, 151-52 (3d Cir. 1939) ("at least 1927° Centigrade" in a patent claim "would not include temperatures of less than 1927° centigrade"); *National Research Development Corp. v. Great Lakes Carbon Corp.*, 410 F. Supp. 1108, 1119 (D. Del. 1975) ("'at least 1000° C.' means a minimum temperature of 1000° C").

[7] *See Hybritech, Inc. v. Abbott Labs.*, 849 F.2d 1446, 1455 (Fed. Cir. 1988) ("at least about 10^8 liters/mole" is literally satisfied by 4.8×10^7 liters/mole and 7.5×10^7 liters/mole); *Robins v. Wettlaufer*, 81 F.2d 882, 893 (C.C.P.A. 1958) (holding that the limitation "substantially coincident with" was broad enough to embrace structures not embraced by "coincident with"); *M & W Elec. Mfg. Co. v. Gatto Elec. Supply Co.*, 260 F. Supp. 891, 896 (N.D. Ohio 1966) (finding that "[t]he term 'approximately or substantially 90°' as employed in the patent in suit . . . covers an angle greater than and less than 90°").

that result is either wrong or should be revisited by this Court.

II. THE RESULT IN THIS CASE WILL NOT BE AFFECTED BY ANY SUBSEQUENT DECISION BY THIS COURT IN *MARKMAN*

As it did while unsuccessfully attempting to obtain rehearing by the Federal Circuit, Rodime attempts to bring this case under the shadow of this Court's pending consideration of the Federal Circuit's in banc decision in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir.), *cert. granted*, 116 S. Ct. 40 (1995) (No. 95-26), by claiming that this Court's decision in *Markman* "controls the disposition of this Petition." Pet. 10. Nothing could be further from the truth.

Regardless of how this Court decides the *Markman* case, the legal analysis and result in this case would be exactly the same. Indeed, this case was decided by the district court well before the Federal Circuit issued its decision in *Markman*. As outlined in the Statement Of The Case *supra*, the case was decided by Judge Doty in accordance with the accepted modes for deciding cases on summary judgment. In that context, he concluded that there was no genuine issue of material fact that would allow a reasonable jury to conclude that the '383 claims at issue had not been broadened. Pet. App. 32a.

Moreover, even though the appeal in this case was decided after the Federal Circuit's *Markman* opinion issued, the Federal Circuit's decision did not even cite *Markman* or any other case decided after *Markman*. Contrary to Rodime's apparent belief, the mere existence of an expert declaration (regardless of content and relevance) is not a magic talisman that prevents summary judgment. In this case, Rodime's evidence was not able to prevent summary judgment because that evidence was not probative to the issue presented and was insufficient to create a genuine issue of material fact. Simply put,

as recognized by the Federal Circuit, *Markman* does not and will not affect this case.[8]

Appellate review of summary judgment has always been *de novo*, and nothing in *Markman* can change that. *E.g.*, *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619 (Fed. Cir. 1995). The Federal Circuit correctly stated that "[w]e review the district court's grant of summary judgment in favor of Quantum . . . to determine whether any genuine issues of material fact are in dispute, and whether any errors of law were made." Pet. App. 7a. The reasons why the district court rejected Rodime's position before *Markman* and the reasons why the Federal Circuit rejected Rodime's position after *Markman* are the same: after viewing the evidence in a light most favorable to Rodime, no reasonable jury could conclude that the '383 patent claims at issue were not broadened.

Finally, Rodime's assertion that it will be denied its Seventh Amendment rights if the Federal Circuit's decision is not reviewed (Pet. 14) is wholly misplaced. A proper grant of summary judgment where warranted by the record does not deprive a litigant of its Seventh Amendment right to a jury trial. *See, e.g., Johnston v. IVAC Corp.*, 885 F.2d 1574, 1577 (Fed. Cir. 1989) (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). Rodime is merely seeking an unwarranted chance at convincing a jury that amending the '383 claims to cover track densities of "at least approximately 600" tpi did not cause those claims to cover certain disk drives with approximately *but less than* 600 tracks per inch that were not covered by the original claims. Because no reasonable jury could agree with Rodime, summary judgment was proper.

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[8] In conjunction with its petition for rehearing at the Federal Circuit, Rodime filed a motion to stay consideration of its petition for rehearing pending a decision by this Court in the *Markman* case. That motion for stay was denied by the Federal Circuit on October 17, 1995.

No decision by this Court in *Markman* will cure the fatal flaws in Rodime's evidence. Thus, even if this Court were to conclude in *Markman* that there are certain underlying questions of fact on the issue of claim interpretation, such a decision by this Court will not alter Rodime's lack of probative evidence in this case or overcome the lack of merit to its position.

III. THE FEDERAL CIRCUIT PROPERLY CONCLUDED THAT THE REMEDY FOR AN IMPROPER BROADENING DURING REEXAMINATION IS INVALIDITY OF THE AFFECTED CLAIMS

The Federal Circuit considered and properly rejected Rodime's attempt to use general statutory construction maxims to show Congress did not intend invalidity as the result for violating section 305. As that court correctly concluded, the list of invalidity defenses found in section 282 is not exclusive and, by its express terms, section 282 allows for the existence of others. Pet. App. 18a. For example, 35 U.S.C. § 101 does not provide for invalidity nor is it one of the conditions of patentability referenced in section (2) of section 282, second paragraph, yet it is routinely asserted as a basis for invalidity. *See, e.g., Raytheon Co. v. Roper Corp.*, 724 F.2d 951 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984).

The PTO has previously rejected claims during reexamination for being broader in any respect than the original claims.[9] If patent claims broadened during reexamination are not supposed to be allowed to issue by the Patent Office, the Federal Circuit properly rejected Rodime's proposition that it is somehow beyond the power of courts to invalidate claims that are nevertheless issued in violation of the law. *See Mahn v. Harwood*, 112 U.S. 354, 358 (1884) (holding it is a valid defense in an

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[9] *See, e.g., In re Freeman*, 30 F.3d at 1464-65; *Ex parte Neuwirth*, 229 U.S.P.Q. 71, 72-73 (Bd. Pat. App. & Int'f 1985) ("the term 'substantially' as a modifier for 'rounded bottom wall' broadens the scope of the claim contrary to [35 U.S.C. § 305]").

infringement suit to show that the commissioner exceeding his authority in granting or reissuing the patent). Simply put, claims issued in violation of the patent statutes cannot stand, and the Federal Circuit correctly held that violations of section 305 are no exception.

In any event, each of Rodime's lesser and allegedly equitable remedies was properly rejected. As the Federal Circuit properly reasoned, if the only possible cost for improperly broadening claims in reexamination is to interpret the claims as having their original claim scope, every reexamination would involve intentional attempts to broaden claims because there would be no penalty, but a potential reward for successfully doing so. As the Federal Circuit correctly concluded, such a result would discourage compliance with section 305 and would attribute a meaningless or absurd result to Congress. Pet. App. 17a.

Until now, compliance with section 305 has been seemingly high. Since the reexamination statute was enacted in 1980, this is the first reported case in which a federal court has had to reach the issue of whether to invalidate a claim issued in violation of section 305. Unless this Court wants to create an incentive for future patent owners to avoid the statute rather than comply with it, and to provoke a corresponding increase in federal court patent litigation over the scope of such resulting claims, any modification of the Federal Circuit's decision enforcing the statutory prohibition against broadening during reexamination is wholly unmerited.

Moreover, Rodime's willingness to be foreclosed from recovering for infringement to the extent of its improper broadening was properly rejected as a rule of law by the Federal Circuit. Rodime's concession is illusory. Rodime is well aware that the significance of its broadened claims in this case related to an effort to establish an actual reduction to practice in the United States earlier than its filing date, not to any alleged infringement of Quantum at the point of the broadening. If Rodime believed that its reexamined claims were enforceable to a narrower

scope, it could have sought to amend them through reissue. Of course, Rodime would have had to prove that the broadening that caused it to claim more than it had a right to claim was due to "error without any deceptive intention." 35 U.S.C. § 251. Such a showing would have been problematic and, even if allowed, would have entitled Quantum to absolute intervening rights under 35 U.S.C. § 252. *See, e.g., Seattle Box*, 731 F.2d at 829.

As recognized by the Federal Circuit, the equities do not favor Rodime because it was Rodime that broadened its claims during reexamination in the face of the statutory prohibition against doing so. Pet. App. 17a. Rodime was the perpetrator, not the victim, of the PTO's alleged error in failing to catch Rodime's violation of section 305. Section 305 states that "the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention so claimed from the prior art cited . . . or in response to a decision adverse to the patentability of a claim of a patent." Pet. App. 40a. As the patent owner responsible for proposing the amendments that resulted in the illegal broadening, Rodime has no one to blame for the violation of law but itself. For that reason, Rodime's suggestion to this Court that the '383 claims had been "inadvertently" broadened (Pet. 19) is both irrelevant and misplaced.

Rodime's unprecedented request to create an equitable "judicial blue-penciling" (Pet. 9) of its broadened claims to eliminate the limitations that resulted in the broadening is contrary to law and was properly rejected.[10]

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[10] *See, e.g., Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 935 (Fed. Cir. 1987) (claim limitations cannot be ignored under the guise of doing equity), *cert. denied*, 485 U.S. 961 (1988); *Autogiro Co. of America v. United States*, 384 F.2d 391, 395-96 (Ct. Cl. 1967) ("[n]o matter how great the temptations of fairness or policy making, courts do not rework claims. They only interpret them.").

Rodime's attempt to condition a holding of invalidity of broadened claims on an inquiry into the patentee's intent is equally improper as a matter of law and policy. A violation of a patent statute does not require wrongful intent to support invalidity as a consequence.[11] Moreover, such an inquiry is clearly foreclosed to Rodime which has kept its prosecution actions enshrouded in claims of attorney-client privilege. Even when it was shown that Rodime had a clear incentive to broaden its claims to support an actual reduction to practice in this country, Rodime kept its reasons for broadening its claims hidden from the view of Quantum and the courts. It is too late for Rodime to make unsupported and unprovable assertions as to its alleged good faith.

Rodime's attempt at Pet. 15-16 to manufacture dire ramifications outside of patent law arising from the Federal Circuit's statutory interpretation of section 305 is transparent. The Federal Circuit's interpretation of section 305 in this case only affects future patent infringement cases in which broadening during reexamination may be included as a defense. As that decision is within the subject matter entrusted to the exclusive jurisdiction of the Federal Circuit, no widespread ramifications outside that field nor any potential conflicts between the circuits can be shown. Therefore, there is no basis for granting Rodime's petition in this case.

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[11] *See, e.g., Graco, Inc. v. Binks Mfg. Co.*, 60 F.3d 785, 789-90 (Fed. Cir. 1995) (specific intent to deceive is not a required element of a best mode defense); *cf. Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1569 (Fed. Cir. 1992) (legal concepts of invalidity and unenforceability are "quite different"); *J.P. Stevens & Co. v. Lex Tex, Ltd.*, 747 F.2d 1553, 1561 (Fed. Cir. 1984) (inequitable conduct renders entire patent unenforceable, not just claims affected).

IV. REVERSAL OF THE FEDERAL CIRCUIT'S DECISION ON THIS ISSUE WOULD NOT CHANGE THE OUTCOME IN THIS CASE

As noted *supra*, Rodime has been concurrently involved in infringement litigation against Seagate Technologies involving the '383 patent. In that case, the United States District Court for the Central District of California also held that the same claims of the '383 patent were invalid for having been broadened in violation of section 305. In other words, that district court independently reached the very same result (on essentially the same motion) as did the district court and the Federal Circuit in this case. Because all five federal judges (and one special master) that have previously examined this issue with respect to this patent have reached the identical result, Rodime's petition does not present either a difficult or controversial issue worthy of this Court's attention.

In addition to holding the '383 patent invalid for having been broadened during reexamination, the district court in the *Seagate* litigation also granted partial summary judgment against Rodime on grounds that all accused Seagate disk drives utilizing voice-coil actuator technology do not infringe any of the asserted claims of the '383 patent. While the specifics of variations in actuator technology are not pertinent here, the court in the *Seagate* litigation recognized that the '383 patent only discloses a disk-drive utilizing a specific form of stepper-motor actuator technology. Because certain other claims between those parties remain to be adjudicated in the *Seagate* litigation, no final judgment has yet been issued in that case. Nevertheless, the only disk drive products manufactured and sold by Quantum that are accused of infringing the '383 patent in this case contain voice-coil actuators which have now been determined to be noninfringing as a matter of law.

Because it cannot be disputed that all of the Quantum products accused of infringing the '383 patent in this case

contain voice-coil actuators, the district court's decision in the *Seagate* litigation will, under the principles of collateral estoppel and issue preclusion, foreclose any future possibility of finding of infringement against Quantum in the present case. *See, e.g., Blonder-Tongue Lab., Inc. v. University of Ill. Found.*, 402 U.S. 313 (1971), *Freeman*, 30 F.3d at 1465-69. Therefore, even if the Federal Circuit's conclusion of invalidity were to be reversed in this case, Rodime could not prevail against Quantum on the issue of infringement following a remand to the district court. For that additional reason, Rodime's petition should be denied.

CONCLUSION

For the reasons stated above, Quantum respectfully requests that the Petition for Writ of Certiorari be denied.

Respectfully submitted,

JOHN F. LYNCH
Counsel of Record
RICHARD L. STANLEY
J. MIKE AMERSON
GARY J. FISCHMAN
ARNOLD, WHITE & DURKEE
750 Bering Drive
Suite 400
Houston, Texas 77057
(713) 787-1400
Counsel for Respondent
Quantum Corporation

Of Counsel:
DAVID B. HARRISON
QUANTUM CORPORATION
500 McCarthy Boulevard
Milpitas, California 95035
(408) 894-6247

TERENCE M. FRUTH
DOUGLAS L. ELSASS
FRUTH & ANTHONY PA
3750 IDS Center
80 South Eighth Street
Minneapolis, Minnesota 55402
(612) 349-6969

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